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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
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Volker Brod

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EXAMINER

MCCLELLAND, KIMBERLY KEIL

ART UNIT

PAPER NUMBER

1791

NOTIFICATION DATE

DELIVERY MODE

02/04/2010

ELECTRONIC

Please find below and/or attached an Office communication concerning this application or proceeding.

The time period for reply, if any, is set in the attached communication.

Notice of the Office communication was sent electronically on above-indicated "Notification Date" to the following e-mail address(es):

docketing-patent@blacklaw.com
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Office Action Summary	Application No. 10/566,736	Applicant(s) BROD ET AL.	
	Examiner KIMBERLY K. MCCLELLAND	Art Unit 1791	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 02 March 2009.
- 2a) ☒ This action is **FINAL**. 2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 11-18 and 20-28 is/are pending in the application.
- 4a) Of the above claim(s) 20-28 is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 11-18 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☒ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☒ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
 2. ☐ Certified copies of the priority documents have been received in Application No. _____.
 3. ☒ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- | | |
|--|---|
| 1) <input type="checkbox"/> Notice of References Cited (PTO-892) | 4) <input type="checkbox"/> Interview Summary (PTO-413) |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | Paper No(s)/Mail Date. _____ |
| 3) <input checked="" type="checkbox"/> Information Disclosure Statement(s) (PTO/SB/08) | 5) <input type="checkbox"/> Notice of Informal Patent Application |
| Paper No(s)/Mail Date <u>07/29/09</u> . | 6) <input type="checkbox"/> Other: _____ |

DETAILED ACTION

Response to Amendment

1. Examiner notes applicant has stated in the response filed 03/02/09 that claim 19 is canceled. However, examiner notes the status identifier of dependent claim 19 is listed as "withdrawn". Correction is required.
2. Applicant is reminded they need to explicitly point out where support for all the newly claimed features comes from as required by MPEP 714.02 and 2163.06. See 37 CFR 1.111.

Claim Rejections - 35 USC § 112

3. In light of applicant's remarks filed 03/02/09, the rejection of claims 15 under 35 U.S.C. 112, has been withdrawn.

Claim Rejections - 35 USC § 103

4. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

5. Claims 11-16 and 18 are rejected under 35 U.S.C. 103(a) as being unpatentable over U.S. Patent Application Publication No. 2003/0136503 to Green et al. in view of U.S. Patent No. 6,280,544 to Fox et al.

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6. With respect to claim 1, Green et al. discloses an RFID labeling apparatus, including a first device for outputting the at least one web material (500) at a predefined speed; a carrier belt (See paragraph 0023) for transporting the one or more transponder devices at the predefined speed; and a bonding device (ABD) for bonding the one or more released transponder devices to the at least one web material at the predefined speed (See paragraphs 0089-0091 and Figure 10). However, Green et al. does not specifically disclose a wedge-shaped device having a surface configured to deflect the carrier belt at the predefined speed in a direction to allow the release of the one or more transponder devices at a position defined by a section between the carrier belt and the at least one web material.

7. Fox et al. discloses an application system, including a wedge-shaped device having a surface configured to deflect the carrier belt at the predefined speed in a direction to allow the release of the one or more transponder devices at a position defined by a section between the carrier belt and the at least one web material (46; See Figures 2 and 4). It would have been obvious to one of ordinary skill in the art at the time the invention was made to substitute the peeling wedge taught by Fox et al. for the peeling roller of Green et al. Simple substitution of one known peeling element for another would produce the predictable result of effectively removing RFID tags from a carrier. The motivation would have been to improve separation of the rf component from the rf sheetstock, improving production speed and efficiency.

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8. As to claim 12, Green et al. discloses the bonding device comprises at least one unit for producing at least one of a soldering bond, an adhesive bond, a laser-welded bond, or an ultrasonic bond (See paragraph 0091).

9. As to claim 13, Green et al. discloses the carrier belt includes a belt (See paragraph 0023) for supporting the one or more transponder devices, and a supply unit for supplying the transponder devices to the belt (608).

10. As to claim 14, Green et al. discloses the supply unit comprises at least one unwinding roll (608) and a speed regulating unit (See paragraph 0089). Examiner notes the phrase, “for measuring the speed of the carrier belt and the first device and for synchronizing the speed of the carrier belt with the speed of the first device” is considered intended use of the currently claimed invention. Consequently, this limitation is not found to structurally define the current invention.

11. As to claim 15, Green et al. discloses the bonding device comprises a curing unit for curing the bonds according to at least one of air, UV irradiation, laser irradiation, thermodes or electron beam irradiation (See paragraph 0091).

12. As to claim 16, Green et al. discloses a plurality of carrier belts and corresponding bonding devices that are positioned at predefined locations relative to the at least one web material (See paragraphs 0101-0103).

13. As to claim 18, Green et al. discloses the bonding device includes two rollers, the rollers rotate counter to each other and the carrier belt releases the transponder devices prior to being fitted to the at least one web material via the rollers (A/B; See Figure 10).

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14. Claim 17 is rejected under 35 U.S.C. 103(a) as being unpatentable over U.S. Patent Application Publication No. 2003/0136503 to Green et al. in view of U.S. Patent No. 6,280,544 to Fox et al. as applied to claims 11-16 and 18 above.

15. With respect to claim 17, Green et al. discloses different methods of fitting the transponder devices to the at least one web material are equivalent (see paragraph 0091). Green et al. also discloses multiple transfer units may be used to transfer a series of rf components (See paragraphs 0101-0103). Green et al. does not specifically disclose the plurality of bonding devices perform two or more different methods of fitting the transponder devices to the at least one web material. However, it would have been obvious to one of ordinary skill in the art at the time the invention was made to use bonding devices performing two or more different methods of fitting the transponder devices to the at least one web material, because the different bonding devices are known in the art to be equivalent. Simple substitution of one known bonding method for another would yield the predictable result of effectively bonding a plurality of rf components to a web.

Response to Arguments

16. Applicant's arguments with respect to claims 11-18 have been considered but are moot in view of the new ground(s) of rejection. Applicant's remaining pertinent arguments are addressed below:

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17. In response to applicant's arguments regarding the rejection of claim 15 under 35 U.S.C. 112, these arguments are persuasive. The rejection of claim 15 under 35 U.S.C. 112 is withdrawn.

18. In response to applicant's argument that the references fail to show certain features of applicant's invention, it is noted that the features upon which applicant relies (i.e., a method, regulating the speed of the web, operation at the same speed, continuous movement, continuous bonding, traveling at a same speed) are not recited in the rejected claim(s). Although the claims are interpreted in light of the specification, limitations from the specification are not read into the claims. See *In re Van Geuns*, 988 F.2d 1181, 26 USPQ2d 1057 (Fed. Cir. 1993). The term "predetermined speed" does not require regulating the speed of the web, operation at the same speed, continuous movement, continuous bonding, or traveling at a same speed, as suggested by applicant. Furthermore, claim 11 is an apparatus claim, not a method claim. No structure is required by this intended use recitation, and cannot distinguish over the prior art.

19. With regard to applicant's arguments against the function of the Green device, these arguments are not persuasive. Examiner notes claims 11-18 are apparatus claims, not method claims. It is well settled that the intended use of a claimed apparatus is not germane to the issue of the patentability of the claimed structure. If the prior art structure is capable of performing the claimed use then it meets the claim. *In re Casey*, 152 USPQ 235, 238 (CCPA 1967); *In re Otto*, 136 USPQ 459 (CCPA 1963).

The device of Green is capable of being operated such that devices travel at a

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predetermined speed, because no further structure is required to transport devices at the same speed as opposed to traveling at differing speeds. Consequently, the intended use of the currently claimed apparatus is not found to structurally distinguish over the prior art apparatus.

20. The examiner would like to note that while features of an apparatus may be recited either structurally or functionally, claims directed to an apparatus must be distinguished from the prior art in terms of structure rather than function. In *re* Schreiber, 128 F.3d 1473, 1477-78, 44 USPQ2d 1429, 1431-32 (Fed. Cir. 1997); “[A]pparatus claims cover what a device is, not what a device does.” *Hewlett-Packard Co. v. Bausch & Lomb Inc.*, 909 F.2d 1464, 1469, 15 USPQ2d 1525, 1528 (Fed. Cir. 1990) (emphasis in original). A claim containing a “recitation with respect to the manner in which a claimed apparatus is intended to be employed does not differentiate the claimed apparatus from a prior art apparatus” if the prior art apparatus teaches all the structural limitations of the claim. *Ex parte Masham*, 2 USPQ2d 1647 (Bd. Pat. App. & Inter. 1987). See MPEP § 2114.

21. In response to applicant's arguments against the references individually, one cannot show nonobviousness by attacking references individually where the rejections are based on combinations of references. See *In re Keller*, 642 F.2d 413, 208 USPQ 871 (CCPA 1981); *In re Merck & Co.*, 800 F.2d 1091, 231 USPQ 375 (Fed. Cir. 1986).

22. In response to applicant's argument that the references fail to show certain features of applicant's invention, it is noted that the features upon which applicant relies

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(i.e., simultaneously performing two different methods) are not recited in the rejected claim(s). Although the claims are interpreted in light of the specification, limitations from the specification are not read into the claims. See *In re Van Geuns*, 988 F.2d 1181, 26 USPQ2d 1057 (Fed. Cir. 1993).

23. In response to applicant's argument that Fox discloses a printer housing, the test for obviousness is not whether the features of a secondary reference may be bodily incorporated into the structure of the primary reference; nor is it that the claimed invention must be expressly suggested in any one or all of the references. Rather, the test is what the combined teachings of the references would have suggested to those of ordinary skill in the art. See *In re Keller*, 642 F.2d 413, 208 USPQ 871 (CCPA 1981).

Conclusion

Any inquiry concerning this communication or earlier communications from the examiner should be directed to KIMBERLY K. MCCLELLAND whose telephone number is (571)272-2372. The examiner can normally be reached on 8:00 a.m.-5 p.m. Mon-Thr.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Philip C. Tucker can be reached on (571)272-1095. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

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Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.

/Kimberly K McClelland/
Examiner, Art Unit 1791

KKM

/Philip C Tucker/
Supervisory Patent Examiner, Art Unit 1791